

**REMARKS**

This paper replaces the response to the Final Rejection filed on September 5, 2008, which was not entered by the Examiner. Claims 1-31 were pending. Claims 1, 9, 17, and 24 are independent claims. Independent claims 1 and 9, and dependent claims 3, 8, and 11-16 have been amended. Dependent claims 2 and 10 have been canceled. Therefore, claims 1, 3-9, and 11-31 remain pending.

In the Advisory Action, the Examiner indicated that the rejections from the Final Office Action would stand. In the Final Office Action, the Examiner rejected claims 1-8 under 35 USC § 101 for allegedly being directed to non-statutory subject matter. Claims 9-16 were rejected under 35 USC § 112, second paragraph, as being indefinite. Claims 1, 4, 9, 12, 17-19, 24, and 27 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Applicants' Background of the Invention, U.S. Patent Application Publication No. 20020138416 ("Applicants' Background"), in view of U.S. Pat. No. 6,266,655 to Kalyan ("Kalyan"). Claims 2, 3, 5-8, 10, 11, 13-16, 20-23, 25-26, and 28-31 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Applicants' Background in view of Kalyan, further in view of U.S. Patent Application Publication No. 20020091699 ("Norton").

In view of the amendments and the following arguments, all claims are believed to be in condition for allowance. Therefore, this response is believed to be a complete response to the Final Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers.<sup>1</sup> Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to

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1. As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

**I. Claims 1 and 3-8 Are Directed to Statutory Subject Matter Under Section 101.**

The Examiner rejected claims 1-8 under Section 101 as allegedly being directed to non-statutory subject matter. Dependent claim 2 has been cancelled. Therefore, claims 1 and 3-8 stand rejected under Section 101. The Examiner did not rely on any recent case law to support his position, nor did the Examiner apply the PTO's "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (October 26, 2005). However, since the Examiner issued the Final Office Action, the Court of Appeals for the Federal Circuit addressed the issue of statutory subject matter in *In re Bilski*, 2007-1130 (Fed. Cir. Oct. 30, 2008). Notably, while discussing the now controlling "machine-transformation test" for determining statutory subject matter under Section 101, the Federal Circuit stated that "[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus." *Bilski* at 24.

Accordingly, independent claim 1 has been amended, and now includes the following recitations:

- "identifying the plurality of assets, wherein at least a portion of the plurality of assets are identified by utilizing a computer to electronically scan the plurality of assets via a network;"
- "storing the identified assets electronically in the computer;"
- "electronically storing the at least one identified criterion in the computer;"
- "identifying one or more inventoried assets that relate to the identified criterion by utilizing the computer;"
- "formulating one or more metric equations for each identified criterion by utilizing the computer;" and
- "assessing the risk to the organization based on the measured values of the one or more metric equations by utilizing the computer."

Amended claim 1 is clearly "tied to a particular machine or apparatus," thus addressing both the Examiner's concerns and complying with the Federal Circuit's "machine-transformation

test” as discussed in the recent *Bilski* decision. Therefore, claim 1, as well as claims 3-7 depending therefrom, recite statutory subject matter under Section 101. Applicants therefore respectfully request the Examiner to withdraw the Section 101 rejections of claims 1, and 3-8.

## **II. Claims 9 and 11-16 Are Not Indefinite.**

The Examiner rejected claims 9-16 under Section 112, second paragraph, as being indefinite. Dependent claim 10 has been cancelled. Therefore, claims 9 and 11-16 stand rejected under Section 112. The Examiner’s rejection states that “[t]he ‘means’ recited in claims 9-16 appear to be directed to software. Meanwhile, the preamble of claims 9-16 are directed to [a] ‘system,’ but the body of claims 9-16 do not recite any structural limitations that constitute the claimed system. It is not really clear to the examiner what the applicant is trying to claim.” (Final Office Action, page 3.) The Examiner continued by stating that “[t]hese rejections can be overcome by adding CPU in the claims.” (*Id.*)

Applicants disagree with the Examiner’s Section 112 rejection, noting that the means-plus-function language of claims 9-16 were fully compliant with Section 112, paragraph 6. However, in order to facilitate prosecution, independent claim 9, as well as claims 11-16, have been amended. Claims 9, and 11-16 are now directed to “[a] computing system.” Therefore, Applicants respectfully request that the Examiner withdraw the Section 112 rejection of claims 9 and 11-16.

## **III. Independent Claims 1, 9, 17, and 24 Are Patentable Over Applicants’ Background And Kalyan.**

Independent claims 1, 9, 17, and 24 were rejected under Section 103(a) as allegedly being unpatentable over Applicants’ Background in combination with Kalyan. However, Applicants’ Background is merely background information, and does not teach or suggest numerous recitations found in Applicants’ claims, as discussed in detail below.

### A. Independent Claim 1

- 1. “inventorying a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the electronic asset types are placed”**

The Examiner alleged that the “Inventory and definition” section of Applicants’ Background teaches the identified recitation of claim 1. (Final Office Action, page 4.) Applicants previously argued that Applicants’ Background says nothing at all about “a location asset type [that] includes physical locations where the electronic asset types are placed.” The Examiner responded by citing a statement in paragraph 15 of Applicants’ Background that states “[i]n order to measure the theoretical impact of a risk, the organization determines its assets (e.g., electronic devices, electronically stored data, etc.) that are involved in support of critical processes.” (Applicants’ Background: page 4, lines 11-13.)

However, this sentence clearly fails to teach that “each asset is defined to be one of an electronic asset type and a location asset type.” Applicants’ Background merely states that “the organization determines its assets,” and notes that assets can be “electronic devices, electronically stored data, etc.” (Applicants’ Background: page 4, lines 11-13.) Clearly this one sentence fails to teach or suggest that “each asset is defined to be one of an electronic asset type and a location asset type,” as recited in claim 1. In addition, this sentence of Applicants’ Background says nothing at all about how “the location asset type includes physical locations where the electronic asset types are placed.”

- 2. “identifying at least one criterion defining a security objective of the organization”**

The Examiner alleged that the “Vulnerability and threat evaluation” section of Applicants’ Background teaches the identified recitation of claim 1. (Final Office Action, page 4.) Applicants previously argued that Applicants’ Background not only fails to teach or suggest at least this recitation, but also that Applicants’ Background also teaches away from “identifying at least one criterion defining a security objective of the organization.” The Examiner responded

by citing paragraph 17 of Applicants' Background, arguing that the "Vulnerability and threat assessment are criteria defining a security objective of the organization." (Final Office Action, page 7.)

However, Applicants' Background says nothing at all about "identifying at least one criterion defining a security objective of the organization," but merely states that various organizations promulgate criteria, and sets of criteria, to use for vulnerability and threat evaluation. Further, Applicants' Background states that "[v]ulnerability and threat assessment is typically performed by an internal audit department or third party auditor using a set of assessment criteria." (Applicants' Background: page 5, lines 4-6.) Applicants' Background teaches using a pre-defined set of criteria, as opposed to "identifying at least one criterion defining a security objective of the organization," as recited in claim 1. Therefore, Applicants' Background actually teaches away from "identifying at least one criterion defining a security objective of the organization."

**3. "identifying one or more inventoried assets that relate to the identified criterion"**

The Examiner alleged that the "Inventory and definition" section of Applicants' Background teaches "identifying one or more inventoried assets that relate to the identified criterion." (Final Office Action, pages 4-5.) Applicants previously argued that Applicants' Background says nothing at all about "identifying one or more inventoried assets that relate to the identified criterion." The Examiner responded by stating that Applicants' Background "teaches identifying assets and assigning a value to each asset" in paragraph 15. However, assigning a value to an asset is clearly distinguishable from "identifying one or more inventoried assets that relate to the identified criterion." Specifically, Applicants' Background says nothing at all about "identifying one or more inventoried assets *that relate to the identified criterion*," as recited in claim 1.

The cited portion of Applicants' Background states "[o]nce assets have been identified, a value is assigned to each asset." (Applicants' Background: page 4, lines 13-14.) Applicants' Background suggests assigning a value to a previously identified asset. As stated in Applicants'

Background, “[t]his value is not only monetary, but also may be tied to loss of reputation or loss of trust.” (Applicants’ Background: page 4, lines 14-15.) However, the cited portion clearly says nothing at all about identifying an asset that relates to the identified criterion.

Further, Applicants’ Background teaches away from “identifying one or more inventoried assets that relate to the identified criterion.” Applicants’ Background states that “the organization determines its assets . . . [then] a value is assigned to each asset.” (Applicants’ Background: page 4, lines 11-14.) Applicants’ Background teaches performing an inventory of assets and then assigning a value to each asset, as opposed to “identifying one or more inventoried assets that relate to the identified criterion.” Therefore, Applicants’ Background actually teaches away from “identifying one or more inventoried assets that relate to the identified criterion.”

**4. “assessing the risk to the organization based on the measured values of the one or more metric equations”**

Independent claim 1 further recites in part “assessing the risk to the organization based on the measured values of the one or more metric equations.” The Examiner alleged that Applicants’ Background teaches this recitation, and relied on the statement that “[o]nce risk has been assessed and identified, the organization can choose to accept the risk, mitigate the risk, or transfer the risk.” (Final Office Action, page 5.) However, the cited portion is actually discussing an organization’s options *after* assessing the risk, and clearly fails to teach or suggest “assessing the risk to the organization based on the measured values of the one or more metric equations.”

**5. “formulating one or more metric equations for each identified criterion”**

The Examiner admitted that Applicants’ Background fails to teach or suggest the identified recitation, and cited Kalyan to compensate for the deficiencies of Applicants’ Background. (Final Office Action, page 5.) The Examiner stated that “Kalyan disclosed the formulating and solving of equations for identified criteria,” and pointed to Kalyan’s Abstract and elements 42 and 44 of Figure 4. (Final Office Action, page 5.) The Examiner then alleged

that “it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Kalyan into [Applicants’ Background Information] to formulate and solve metric equations defining one or more assets of the organization since doing so would provide answers to business organizational questions in a more efficient and systematic way.” (Final Office Action, page 5.) However, Kalyan is not directed to the subject matter of Applicants’ Background or Applicants’ claims, nor is the section cited by the Examiner relevant to the identified recitation.

Kalyan is directed to “[a] method of valuing resources of an asset intensive manufacturer.” (Kalyan: Abstract.) Applicants previously argued that Kalyan fails to teach or suggest “formulating one or more metric equations for each identified criterion.” The Examiner responded to Applicants’ previous arguments by stating that “Kalyan discloses a method of valuing resources of an asset intensive manufacturer by setting up equations and solving each equation for the resource variables.” (Final Office Action, page 8.) The Examiner then alleged that “since identified criterion, as claimed by the applicant, is a measured variable, and since Kalyan teaches setting up and solving equations for measured variable (i.e., resources of an asset intensive manufacturer), Kalyan teaching certainly meets the applicant’s claimed limitation of ‘formulating one or more metric equations for each identified criterion.’” (Final Office Action, page 8.)

Thus, the Examiner is arguing that Kalyan teaches “setting up and solving equations for [a] measured variable,” and thus teaches “formulating one or more metric equations for each identified criterion.” However, the cited portions of Kalyan do not teach or suggest “formulating one or more metric equations *for each identified criterion*,” as recited in claim 1. Simply teaching setting up and solving equations is clearly distinguishable from “formulating one or more metric equations for each identified criterion,” as recited in claim 1.

The Examiner alleged that Kalyan teaches “formulating one or more metric equations for each identified criterion” by relying on elements 42 and 44 of Figure 4. However, Figure 4 “illustrates how MAV [minimum acceptable values] equations are set up and solved.” (Kalyan: col. 2, lines 20-23.) Figure 4 is a flow chart, where element 42 is the second process step and states “calculate prorated values of product values on each resource used by a product.” Element

43 is the following process step and states “set up  $N_R$  equations each with only one variable, the corresponding  $\lambda$ .” Further, element 44 is the following process step and states “solve each equation using a binary tree to converge to a new  $\lambda$  for each equation.” (Kalyan: Figure 4.) Kalyan says nothing at all about “formulating one or more metric equations for each identified criterion.” To the contrary, Kalyan discloses valuing products and resources with one equation *per resource*, not *per criterion*. Claim 1 clearly recites that “a criterion” relates to “a security objective of the organization.” Clearly a resource that is used to manufacture a product is not, and cannot be equated with, “a criterion” that relates to “a security objective of [an] organization.” Moreover, the differences between Kalyan and claim 1 can be seen in context, at least because the modeling in Kalyan is for the purpose of “valuing resources used to manufacture products” (e.g. Kalyan, col.1, lines 43-45), without regard to “at least one criterion defining a security objective of the organization.”

Kalyan is incapable of being combined with Applicants’ Background. Kalyan is directed to a method of valuing resources of an asset intensive manufacturer by utilizing “a computer-implemented tool that implements a ‘value-management’ (VM) pricing method.” (Kalyan: col. 2, lines 20-23.) Notably, Kalyan is directed to calculating the value various resources during various periods by basing the value on certain principles, such as “future uncertain demand for various products, expected prices for those products, and available capacities of resources during periods required to supply demand when demanded.” (Kalyan: col. 2, lines 54-59.) Clearly, Kalyan is not directed to the recitations found in Applicants’ claims, because Kalyan is concerned with valuing assets based on different and conceptualized market conditions, and has nothing to do with risk assessment.

Accordingly, for at least the foregoing reasons, claim 1, as well as claims 3-8, are patentable over the cited references. Therefore, Applicants respectfully request the Examiner to withdraw the Section 103 rejections of claims 1 and 3-8.

## B. Independent Claims 9, 17, and 24

- 1. “identify a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the electronic asset types are placed”**

Independent claims 9 and 17 each include the identified recitation. Independent claim 24 recites in part “inventorying a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the electronic asset types are placed.” The Examiner alleged that the “Inventory and definition” section of Applicants’ Background teaches this recitation. (Final Office Action, page 4.) However, as discussed above regarding claim 1, Applicants’ Background says nothing at all about how “each asset is defined to be one of an electronic asset type and a location asset type.” In addition, the cited portion of Applicants’ Background clearly fails to teach or suggest that “the location asset type includes physical locations where the electronic asset types are placed.”

- 2. “identify a plurality of criteria, each criterion defining a security objective of the organization”**

Independent claim 9 includes the above-identified recitation. Independent claims 17 and 24 each recites in part “identifying at least one criterion defining a security objective of the organization.” The Examiner alleged that the “Vulnerability and threat evaluation” section of Applicants’ Background teaches this recitation. (Final Office Action, page 4.) However, also as previously discussed regarding claim 1, Applicants’ Background not only fails to teach or suggest at least this recitation, but also that Applicants’ Background also teaches away from “identify[ing] a plurality of criteria, each criterion defining a security objective of the organization.”

**3. “identify a plurality of inventoried assets that relate to each identified criterion”**

Independent claim 9 also includes the above-identified recitation. Independent claims 17 and 24 each recites in part “identify[ing] one or more inventoried assets that relate to the identified criterion.” The Examiner alleged that the “Inventory and definition” section of Applicants’ Background teaches this recitation. (Final Office Action, pages 4-5.) However, also as previously discussed regarding claim 1, Applicants’ Background fails to teach or suggest “identify[ing] a plurality of inventoried assets that relate to each identified criterion.” In addition, the cited portion of Applicants’ Background actually teaches away from the above recitation by teaching “assigning a value to each asset” after “performing an inventory of assets,” in stark contrast to “identify[ing] a plurality of inventoried assets that relate to each identified criterion.”

**4. “formulat[ing] one or more metric equations for each identified criterion”**

Independent claims 9, 17, and 24 each recites in part “formulat[ing] one or more metric equations for each identified criterion.” The Examiner admitted that Applicants’ Background fails to teach or suggest this recitation, and cited Kalyan to compensate for the deficiencies of Applicants’ Background. (Final Office Action, page 5.) As previously discussed regarding claim 1, however, the cited portions of Kalyan do not teach or suggest “formulat[ing] one or more metric equations *for each identified criterion.*” In addition, Kalyan is incapable of being combined with Applicants’ Background.

Accordingly, for at least the foregoing reasons, independent claims 9, 17, and 24, as well the claims depending therefrom, are patentable over the cited references. Therefore, Applicants respectfully request the Examiner to withdraw the Section 103 rejections of claims 9, and 11-31.

**IV. Dependent Claims 4, 12, 19, and 27 Are Patentable Over Applicants' Background And Kalyan.**

**"wherein the plurality of assets are defined to be one of a user type, a user population type, a data type and a network type in addition to the electronic type and the location type, wherein the user type relates to an individual user and the user population type relates to a group of users"**

The Examiner alleged that the "Inventory and definition" section of Applicants' Background teaches the identified recitation. (Final Office Action, page 5.) However, the cited portion of Applicants' Background says nothing at all about further defining the assets into various types, including "a user type, a user population type, a data type, and a network type." The cited portion of Applicants' Background states that an "organization determines its assets (e.g., electronic devices, electronically stored data, etc.) that are involved in support of critical processes." (Applicants' Background: page 4, lines 11-13.). In fact, Applicants' Background makes no mention of "a user type, a user population type, a data type, [or] a network type."

Because Applicants' Background fails to teach or suggest the above-identified recitation, the rejections of claims 4, 12, 19, and 27, and the claims that depend therefrom, should be withdrawn.

**V. Dependent Claims 5, 13, 20, and 28 Are Patentable Over Applicants' Background In Combination With Kalyan And Norton.**

**"establish[ing] at least one relationship between the plurality of assets"**

The Examiner stated that Applicants' Background does not explicitly disclose the identified recitation, and cited Norton to compensate for the acknowledged deficiency of Applicants' Background. (Final Office Action, page 6.)

The Examiner alleged that Norton teaches this recitation on page 4, ¶¶ 85-90. (Final Office Action, page 6.) However, the cited portion of Norton discloses a variety of "asset search options" that "enables a user not only to search for an asset, but also to view a range of detailed information about the selected asset." (Norton: page 4, ¶¶ 85-87.) Norton further discloses that

“[t]he Asset tab 70 displays detailed asset information for the asset selected,” and that such information may include the asset’s serial number, tracking number, purchase order, manufacturer, model number, etc. (Norton: pages 4-5, ¶¶ 88-93.)

Applicants previously argued that the cited portions of Norton fail to teach or suggest “establish[ing] at least one relationship between the plurality of assets.” The Examiner responded by alleging that Figure 8 of Norton “clearly shows at least one relationship between the pluralities of assets.” (Final Office Action, page 8.) However, Figure 8 of Norton is simply a screen shot of a website showing “an exemplary display resulting from the selection of the Option Tab.” (Norton: page 2, ¶ 36.)

Norton not only fails to disclose “establishing at least one relationship between the plurality of assets,” but actually makes no mention of this recitation at all. Because Norton fails to teach or suggest “establishing at least one relationship between the plurality of assets,” the rejections of claims 5, 13, 20, and 28, and the claims that depend therefrom, should be withdrawn.

## **VI. Dependent Claims 6, 14, 21, And 29 Are Patentable Over Applicants’ Background In Combination With Kalyan And Norton.**

**“link[ing] a first asset defined to be in one asset type with a second asset defined to be in another asset type”**

Dependent claims 6, 14, 21, and 29 further recite in part “link[ing] a first asset defined to be in one asset type with a second asset defined to be in another asset type.” The Examiner stated that Applicants’ Background does not explicitly disclose this recitation, and cited Norton to compensate for the acknowledged deficiency of Applicants’ Background. (Final Office Action, page 6.)

Again, the Examiner alleged that Norton teaches this recitation on page 4, ¶¶ 85-90. (Office Action, page 5.) At most, Norton discloses a variety of “asset search options” that allow a user to search for an asset, and view detailed information about a selected asset. (Norton: page 4, ¶¶ 85-87.) Applicants previously argued that the cited portions of Norton fail to teach or suggest “linking a first asset defined to be in one asset type with a second asset defined to be in

another asset type.” The Examiner responded by stating that Figure 1A of Norton “discloses a standardized asset database, wherein different asset types are inherently linked together.” (Final Office Action, page 8.) However, Figure 1A of Norton does not teach or suggest this recitation, explicitly or inherently, contrary to the Examiner’s suggestion. Norton states that Figure 1A “is a block diagram of one preferred embodiment of a hosted asset information management system according to the present invention as a standalone system.” (Norton: page 2, ¶ 28.)

Norton fails to disclose “linking a first asset defined to be in one asset type with a second asset defined to be in another asset type,” and actually makes no mention of this recitation at all. The Examiner’s reliance on any inherent disclosure in Figure 1A is unfounded without additional explanation. Because Norton fails to teach or suggest “linking a first asset defined to be in one asset type with a second asset defined to be in another asset type,” the rejections of claims 6, 14, 21, and 29, and the claims that depend therefrom, should be withdrawn.

## **VII. Dependent Claims 7, 15, 22, And 30 Are Patentable Over Applicants’ Background In Combination With Kalyan And Norton.**

**“link[ing] a first asset defined to be in one asset type with a second asset defined to be in the same asset type”**

The Examiner stated that Applicants’ Background does not explicitly disclose the identified recitation, and cited Norton to compensate for the acknowledged deficiency of Applicants’ Background. (Final Office Action, page 6.) Again, the Examiner alleged that Norton teaches this recitation on page 4, ¶¶ 85-90. (Final Office Action, page 6.) However, Norton says nothing at all about “linking a first asset defined to be in one asset type with a second asset defined to be in the same asset type,” as Applicants previously argued. The Examiner responded by alleging that this recitation is inherently disclosed in Figure 1A of Norton. (Final Office Action, page 8.) However, for at least the reasons stated above with respect to dependent claims 6, 14, 21, and 29, Norton also fails to teach or suggest at least this recitation of dependent claims 7, 15, 22, and 30.

Because Norton fails to teach or suggest “linking a first asset defined to be in one asset type with a second asset defined to be in the same asset type,” the rejections of claims 7, 15, 22, and 30, and the claims that depend therefrom, should be withdrawn.

### **CONCLUSION**

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-0525. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: November 24, 2008

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